

REMARKS

Claim Rejections under 35 U.S.C. § 112, First Paragraph.

The first paragraph of 35 U.S.C. § 112 (“Section 112”) requires that the specification contain “a written description of the invention, and of the manner and process of making and using it . . . [so] as to enable any person skilled in the art . . . to make and use the same.”

Claims 1, 2 and 4-28 stand rejected under Section 112, first paragraph, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In response, Applicant has amended independent claim 1 to recite the steps of “obtaining a quantity of unprocessed *Morinda Citrifolia* fruit juice, wherein said fruit juice includes Proxeronine,” and “applying said topical skin toner composition to said skin, wherein the application of said topical cosmetic skin toner composition activates a release of Xeronine from said Proxeronine.” Applicant respectfully submits that claim 1, as amended, is adequately enabled by the specification as filed.

Indeed, the specification explains that “Noni contains the inactive form of the enzyme Proxeronase which releases Xeronine from proxeronine.” See Specification, p. 23. Since claim 1 makes clear that Noni juice also contains Proxeronine, the function of the Noni-containing topical skin toner composition in releasing Xeronine from Proxeronine is properly enabled.

Claims 2-24 are also enabled as each such claim adds further limitations, each adequately enabled, to otherwise allowable subject matter. Claims 25-28 do not recite any use of Proxeronase and thus were improperly rejected.

In light of the foregoing, Applicant respectfully requests withdrawal of the rejections of claims 1, 2 and 4-28 under Section 112, First Paragraph.

Claim Rejections under 35 U.S.C. § 112, Second Paragraph.

Claims 1, 2 and 4-28 stand rejected under Section 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In response, Applicant has amended claim 1 and claims 25-28 to comply with the technical requirements of Section 112, Second Paragraph as suggested by the Examiner.

Applicant, however, respectfully traverses the Examiner's assertion that the terms "PEG-115M," "FD&C Blue No. 1," "FD&C Yellow No. 5," "SD Alcohol 40-B," and "PG" are trademarks improperly included in the patent claims. Rather, Applicant respectfully submits that such designations are widely recognized in the art as standard chemical nomenclature which describe specific chemical compositions.

Indeed, PEG is the widely recognized abbreviation for polyethylene glycol. The number following PEG indicates the viscosity of the substance. Likewise, PG is the abbreviated form of propylene glycol. See <http://web.singnet.com/sg/~pisces/trial3.html>. Color additives labeled FD&C indicate that such colors are certified for use in food, drugs and cosmetic products, whereas color additives labeled D&C indicate that such colors are certified for use in drugs and cosmetics. "Ext. Violet 2" and "Green 5" have been amended to include their appropriate D&C designations. The particular chemical compositions for all certified colors are delineated by 21 C.F.R. § 74.101 et al. SD Alcohol 40-B is standard shorthand for Specially Denatured Alcohol. The number following the SD designation indicates how the alcohol was denatured, according to the formulary of the United States Bureau of Alcohol, Tobacco and Firearms. See <http://vm.cfsan.fda.gov/~dms/cos-227.html>.

In light of the foregoing amendments and remarks, Applicant respectfully requests withdrawal of the rejections of claims 1, 2 and 4-28 under Section 112, Second Paragraph.

Claim Rejections under 35 U.S.C. § 102.

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) (“Section 102(b)”) based upon a public use or sale of the invention more than one year prior to the application date as disclosed by U.S. Pat. No. 5,288,491 to Moniz (“Moniz”).

An invention is unpatentable under 35 U.S.C. § 102(b) (“Section 102(b)”) if “the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” A Section 102(b) rejection is only appropriate, however, where the “reference fully discloses in every detail the subject matter of a claim.” *Application of Foster*, 383 U.S. 966 (1966). For the reasons set forth below, Applicant submits that the reference cited by the Examiner does not teach each and every element of the claimed invention, as amended, and thus does not bar the claimed invention as a public use of the invention more than one year prior to the date of application.

As amended, claim 1 recites “obtaining a quantity of Morinda Citrifolia fruit juice [and] combining said fruit juice with a cosmetically suitable carrier agent to create said topical cosmetic skin toner composition.” In addition, Applicant has amended claim 1 to recite the step of “applying said topical cosmetic skin toner composition to said skin.” These amendments find support in the specification as filed, as the specification teaches that “Noni fruit juice is present in an amount from about 0.1 to 80 percent by weight” and “may be combined with other ingredients commonly found in toners.” See Specification, p. 26, ln. 10-11, p. 27, ln. 6-7. In addition, the specification discloses that the present invention is applied topically as part of a daily skin care regime. See Specification, p. 6. Applicant finds no mention of a topical application of a composition containing Noni fruit juice in Moniz, nor any equivalent thereof. The claimed method for making and administering a topical cosmetic skin toner composition is thus not barred by Moniz under Section 102(b).

Indeed, Moniz's only reference to a prior use of Noni fruit juice is that "extracted juice was diluted with water and taken as a drink before meals and between resting times" as part of ancient Hawaiian folk medicine. See Col. 12, ln. 58-9. As Moniz fails to disclose any topical application of Noni fruit juice for any purpose whatsoever, Moniz fails to anticipate the present invention as claimed.

Claim 2 places further limitations on otherwise allowable subject matter and should not therefore be considered anticipated under Section 102(b).

In light of the foregoing amendments and remarks, Applicant respectfully requests withdrawal of the rejections of claims 1 and 2 under Section 102(b).

Claim Rejections under 35 U.S.C. § 103.

An invention is unpatentable under 35 U.S.C. § 103(a) ("Section 103") "if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

To establish a *prima facie* case of obviousness, three criteria must be met. "First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2142.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

A “clear and particular” showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.* For the reasons set forth below, Applicant submits that the prior art fails both to teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicant’s claims are not obvious in view of the prior art references.

Claims 1, 2 and 4-17 stand rejected under Section 103 as unpatentable over the Nonidrink.com advertisement (the “Advertisement”) in view of U.S. Pat. No. 5,288,491 to Moniz (“Moniz”). Claims 18-28 stand rejected under Section 103 as unpatentable over the Advertisement in view of Moniz and further in view of U.S. Pat. No. 5,472,699 to Duffy (“Duffy”).

In response, Applicant first submits that the Advertisement was improperly cited as prior art due to the Examiner erroneously attributing the 1998-1999 copyright date to the Advertisement for the Tahitian Noni Skin Care System, rather than to the NoniDrink.com website to which it refers. The Advertisement for the Tahitian Noni Skin Care System was later added to the website and does not qualify as prior art under Section 102(b). Moreover, the accompanying article from Kuala Lumpur dated June 17, 1999, refers to the Tahitian Noni Skin Treatment System, which system comprises differently formulated products from the Tahitian Noni Skin Care System products referenced on the website.

Applicant further submits that the properly considered above-referenced art, considered cumulatively, does not render the present invention obvious since the method of the present invention is neither disclosed nor suggested.

Indeed, Moniz discloses a method for processing the Morinda citrifolia plant into powder. Although Moniz discloses that Morinda citrifolia fruit juice may be ingested by a patient to treat certain systemic disorders, Moniz neither discloses nor suggests topical application of a Morinda

citrifolia fruit juice-containing compound, as disclosed by the present application. Indeed, Moniz teaches away from topical application of a Morinda citrifolia fruit juice-containing compound as Moniz emphasizes that the benefits of noni juice may only be realized upon activation of the “appreciable amounts of the precursor of xeronine” present in the juice. Moniz notes that the best chance of noni juice becoming activated is if the juice is taken on an empty stomach. See col. 3, ln. 12-17. Moniz would thus likely discourage one skilled in the art from applying noni juice topically.

Duffy, on the other hand, discloses a “method for reducing the visible size of facial skin pores by applying a novel composition which comprises an oil absorbing powder, a botanical astringent and a biological compound.” Duffy neither discloses nor suggests utilizing Noni fruit juice for any purpose whatsoever.

In light of the above, Applicant respectfully submits that the inability of the properly considered combined references to produce Applicant’s invention and the lack of any suggestion or motivation to modify such art to produce Applicant’s invention renders the present invention non-obvious in view of such references. Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 1, 2 and 4-28 under Section 103.



Conclusion

Based on the foregoing, Applicant believes that the claims of the present invention are in condition for allowance and respectfully requests the same.

Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to initiate a telephone interview with undersigned counsel.

DATED this 13 day of December, 2002.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

1. A method for making and administering ~~providing~~ a topical cosmetic skin toner composition that may be spread on skin to hydrate and balance pH levels in said skin, said method comprising the steps of ~~for~~:

 ~~providing~~ obtaining a quantity of ~~pure~~ *Morinda Citrifolia* fruit juice, wherein said fruit juice includes Proxeronine;

 combining said fruit juice with a cosmetically suitable carrier agent to ~~provide~~ create said topical cosmetic skin toner composition ~~that may be spread on said skin to hydrate and balance pH levels in said skin; and~~

 applying said topical cosmetic skin toner composition to said skin, wherein the application of said topical cosmetic skin toner composition activates ~~using a quantity of Proxeronase to activate~~ a release of Xeronine from said Proxeronine, said Xeronine being capable of enhancing and improving cellular vitality in said skin.
2. The method of claim 1, wherein said release of Xeronine occurs from the interaction of said Proxeronine and at least one of:
 - (i) ~~said a quantity of~~ Proxeronase present in said fruit juice; and
 - (ii) a quantity of Proxeronase present in said skin.

24. The method of claim 1, further comprising the step for combining one or more additional ingredients into said topical cosmetic skin toner composition, wherein said one or more additional ingredients are selected from the group consisting of SD alcohol 40-B, witch hazel distillate, menthol, aloe barbadensis extract, glycerin, diglycerin, eucalyptus globulus oil, fragrance, butylene glycol, PG, Ext. D&C Violet 2, and D&C Green green 5.
25. A method for hydrating skin, said method comprising the steps of for:
~~providing pure~~ obtaining a quantity of *Morinda citrifolia* fruit juice;
combining said ~~pure~~ fruit juice with a cosmetically suitable carrier agent to ~~provide~~ create
a topical cosmetic skin toner composition, wherein said ~~pure~~ fruit juice is present
in an amount between about 10-80 percent by weight; and
~~providing~~ applying said cosmetic skin toner composition to said skin to hydrate the skin.
26. A method for balancing pH levels in skin, said method comprising the steps of for:
~~providing pure~~ obtaining a quantity of *Morinda citrifolia* fruit juice;
combining said ~~pure~~ fruit juice with a cosmetically suitable carrier to ~~provide~~ create a
topical cosmetic skin toner composition, wherein said ~~pure~~ fruit juice is present in
an amount between about 10-80 percent by weight; and
~~proving~~ applying said cosmetic skin toner composition to said skin to balance pH levels
in the skin.
27. A method for balancing pH levels in skin, ~~the~~ said method comprising the steps of for:

~~providing pure~~ obtaining a quantity of *Morinda citrifolia* fruit juice;
~~providing~~ combining said fruit juice with a balancing agent;
combining said fruit juice and said balancing agent with a cosmetically suitable carrier to
create a topical cosmetic skin toner composition; and
~~providing~~ applying said composition to said skin to balance pH levels in the skin.

28. A method for hydrating skin, ~~the~~ said method comprising the steps of ~~for~~:

~~providing pure~~ obtaining a quantity of *Morinda citrifolia* fruit juice;
~~providing~~ combining said fruit juice with a hydrating agent;
combining said fruit juice and said hydrating agent with a carrier agent to create a topical
cosmetic hydrating skin toner composition; and
~~providing~~ applying said composition to said skin to hydrate the skin.